

Claims 6 and 18 are hereby amended to recite percentage of fiber weight. Support for this amendment was present in the original disclosure at, for example, page 7, lines 16-18. Claim 32 is hereby cancelled.

**Rejection Under 35 U.S.C. § 102(b):**

Claims 1-42 were rejected under 35 U.S.C. § 102(b) as being anticipated by Brungardt (5,766,417).

Rejection under 35 U.S.C. § 102 requires the prior art disclose each and every limitation of the claimed invention (MPEP § 706.02). In determining anticipation, no claim limitation may be ignored. See *Pac-Tex, Inc. v. Amerace Corp.*, 14 USPQ2d 1871 (Fed. Cir. 1990). Anticipation requires the disclosure, in a prior art reference, of each and every recitation as set forth in the claims. See *Titanium Metals Corp. v. Banner*, 227 USPQ 773 (Fed. Cir 1985), *Orthokinetics, Inc. v. Safety Travel Chairs, Inc.*, 1 USPQ2d 1081 (Fed. Cir 1986), and *Akzo N.V. v. U.S. International Trade Commissioner*, 1 USPQ2d 1241 (Fed. Cir 1986). There must be no difference between the claimed invention and reference disclosure for an anticipation rejection under 35 U.S.C. § 102. See *Scripps Clinic and Research Foundation v. Genentech, Inc.*, 18 USPQ2d 1001 (CAFC 1991) and *Studiengesellschaft Kohle GmbH v. Dart Industries*, 220 USPQ 841 (CAFC 1984). The evidentiary record fails to teach each limitation of the present invention in view of the patentable distinction of the 2-oxetanones at issue.

The present invention relates to papermaking sizes based on 2-oxetanones. The art is familiar with 2-oxetanones, *per se*. However, the present invention requires the fatty acids comprising said oxetanones to be fully saturated. (See page 5, lines 9-11). In contradistinction, Brungardt requires at least 25% of the fatty acids be unsaturated. (Column 4, lines 29-30). An oxetanone required to contain at least 25% unsaturated fatty acids does not anticipate an oxetanone required to consist only of completely saturated fatty acids.

**Conclusion:**

It is respectfully requested that the foregoing amendment be entered, that the application as so amended receive an examination on the merits, and that the claims as now presented receive an early allowance.

In the event the Examiner believes an interview might serve to advance the prosecution of this application in any way, the undersigned attorney is available at the telephone number noted below.

The Commissioner is hereby authorized to charge any fees or credit any overpayment associated with this communication, including any extension fees or fees for the net addition of claims, to Deposit Account No. 22-0185.

Respectfully submitted,



---

John A. Evans, Reg. No 44,100  
Connolly, Bove, Lodge & Hutz LLP  
1990 M Street, N.W.  
Washington, D.C. 20036-3425  
Telephone: 202-331-7111

Date: 8/8/02